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09/869,205	09/17/2001	David Sadek	136.160	9799

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EXAMINER

HOLMES, MICHAEL B

ART UNIT PAPER NUMBER

2121

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.





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### Examiner's Detailed Office Action

1. This Office Action is responsive to communication received on January 25, 2005.

Amendment under 37 CFR § 1.111 reconsideration and allowance of application is respectfully requested by applicant.

2. Claims 1-15 have been cancelled.
3. Claims 16-25 have been added and examined.

### Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The invention as disclosed in claims 16-25 are rejected under 35 U.S.C. 101 as being non-statutory subject matter.
6. Regarding claims 16-23 & 25, the claims appear to be a system of software, per se, lacking the hardware necessary to realize any underlying functionality i.e., software in an of itself, is not patentable. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the

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specification. The claims must also reflect the scope and breath of applicant's invention. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

### Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 24 & 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. Claims 24 & 25 qualify as a single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. *see* MPEP 2164.08(a) Single Means Claim

## Response to Arguments

10. Applicant's arguments are persuasive over the prior art.

## Examiner's Comments

11. Examiner's search has failed to reveal prior art to reject the claims. Moreover, as aforementioned, applicant's arguments are persuasive over the prior art. However, outstanding issues remain regarding 35 U.S.C. 101 & 35 U.S.C. 112, first paragraph, respectively.

## Examiners Summary

12. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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### Correspondence Information

13. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email [Michael.holmesb@uspto.gov](mailto:Michael.holmesb@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (703) 746-7239.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

***Michael B. Holmes***

Patent Examiner

Artificial Intelligence

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United States Department of Commerce

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*Monday, March 13, 2006*

*MBH*



**Anthony Knight**

**Supervisory Patent Examiner  
Group 3600**